



D-1118R2

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Previous Appeal No.: 2003-0098)	
)	
In re Application of)	
Alan J. Rozlosnik, et al.)	
)	Art Unit 2876
Application No.: 09/398,182)	
)	
Confirmation. No.: 9748)	Patent Examiner
)	April A. Taylor
Filed: September 17, 1999)	
)	
Title: Receipt Delivery System)	
for Secure Depository)	

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**BRIEF OF APPELLANTS
PURSUANT TO 37 C.F.R. § 41.37**

Sir:

The Appellants hereby submit their Third Appeal Brief concerning the above-referenced Application. This Third Appeal Brief is in response to the Office Action dated August 24, 2005, which reopened prosecution subsequent to a decision by the Board of Patent Appeals and Interferences (hereinafter "Board"). Appellants respectfully request reinstatement of their appeal.

(i)

REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

(ii)

RELATED APPEALS AND INTERFERENCES

In this application a Board decision regarding Appeal No. 2003-0098 was previously rendered on June 22, 2004. In said decision the Examiner was reversed on all issues.

This application and application 10/280,238 both claim priority to provisional application 60/114,036. Application 10/280,238 has also been appealed. However, it is respectfully requested that the Board make its own determination regarding the pertinence of application 10/280,238. Appellants, Appellants' legal representative, and assignee believe that there are no other related appeals or interferences pertaining to this matter.

(iii)

STATUS OF CLAIMS

Claims 1-18 are pending in the Application.

Claims rejected: 1-18

Claims allowed: none

Claims confirmed: none

Claims withdrawn: none

Claim objected to: none

Claims canceled: none

Appellants appeal the rejections of claims 1-18, inclusive. These rejections were the only rejections present in the Office Action (“Action”) dated August 24, 2005.

(iv)

STATUS OF AMENDMENTS

Although claims have been rejected at least four times, no final rejection is pending.

Therefore, no amendments to the claims were requested to be admitted after a final rejection.

The non-final Action dated August 24, 2005 reopened prosecution for a second time subsequent to the Board decision (June 22, 2004) in Appeal No. 2003-0098. The Board decision completely reversed the Examiner. In response to the Board decision the Office reopened prosecution on September 17, 2004. Appellants traversed the reopening with the filing of a Second Appeal Brief on February, 14, 2005. In response to the Second Appeal Brief the Office again reopened prosecution on August 24, 2005.

A repeated imposition of new grounds of rejection by the Office in an effort to deny any Appellant judicial review constitutes an abuse of agency authority. Such agency action would violate the Administrative Procedures Act, 5 U.S.C. § 701 *et seq.* Such agency action would also violate the fundamental legal principle that an administrative agency may not avoid review of its actions by engaging in repetitive activity which does not remain in place long enough to enable judicial review. *Southern Pacific Terminal Co. v. Interstate Commerce Com.*, 219 U.S. 498, 55 L.Ed. 310, 31 S. Cr. 279 (1911).

In spite of the Office's propensity to continually reopen prosecution, the same claims that were pending at the time of the Board decision remain pending. As shown in more detail herein, these claims are also allowable over the latest new grounds of rejection. Thus, Appellants again respectfully request reinstatement of their appeal.

(v)

SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of exemplary forms of the claimed invention:

For reasons of brevity, claim language may be referred to herein (and in Appellants' arguments) in a shortened version. For example, language such as "at least one" may be simply referred to as "a". Any generalized statement in this Appeal Brief is not to limit any of the mentioned claims in any manner. Please refer to the specific claim for the exact claim language.

With respect to independent claim 1

An exemplary form of the invention is directed to a method. The method includes conducting at least one transaction at a deposit accepting machine (10; Figure 1; page 10, lines 2-4). The method further includes printing a receipt (109) including indicia corresponding to the transaction with a printer (122) in an interior area of the machine (10). The method additionally includes (Figures 38 and 39) extending a receipt (109) intermediate of an exterior wall (121) of the machine and an overlying member (30), wherein the overlying member (30) includes an aperture (125) therein sized for accepting a finger of a user. The method also includes moving the receipt (109) in sandwiched relation between a finger extended in the aperture (125) and the machine's exterior wall (121) to remove the receipt from between the exterior wall (121) and the overlying member (30) (e.g., page 17, lines 4-19).

With respect to independent claim 16

Another exemplary form of the invention is directed to a method. Support in the disclosure for like reference numerals has previously been provided. The method includes extending a printed receipt (109) intermediate of an exterior wall (121) of a deposit accepting machine (10) and an overlying member (30), where the overlying member (30) includes an aperture (125) therein sized for accepting a finger of a user (page 17, line 1) (Figures 38 and 39). The method further includes moving the receipt (109) in sandwiched relation between a finger extended in the aperture (125) and the machine's exterior wall (121) to remove the receipt from between the exterior wall and the overlying member (30) (page 17, lines 4-19).

With respect to independent claim 18

Another exemplary form of the invention is directed to a method. Support in the disclosure for like reference numerals has previously been provided. The method includes extending a printed receipt (109) intermediate of an exterior wall (121) of a deposit accepting machine (10) and an overlying member (30), where the overlying member includes an aperture (125) therein sized for accepting a finger of a user (page 17, line 1). The exterior wall (121) includes an opening (113). The overlying member (30) extends from generally above the opening (113) to a generally downward facing edge (119) positioned below the opening (113). The aperture (125) extends below the opening (113).

The method of claim 18 further includes moving (page 17, lines 4-19; Figures 38 and 39) the receipt (109) in sandwiched relation between a finger extended in the aperture (125) and the machine's exterior wall (121) to remove the receipt (109) from between the exterior wall (121) and the overlying member (30), with the receipt (109) moved generally downward by movement of the finger in the aperture (125). The overlying member (30) is disposed in proximity to the exterior wall (121) such that the receipt (109) extending therebetween cannot be manually grasped (page 16, lines 20-22) adjacent the edge with fingers prior to moving the receipt (109) by engagement with a finger through the aperture (125) (page 17, lines 11-13). The method additionally includes, subsequent to moving the receipt (109) by movement of the finger in the aperture (125) (page 17, lines 11-13), manually grasping the receipt (109) (page 17, lines 17-19).

(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The questions presented in this appeal are:

- 1). Whether claims 1-3, 6-9, and 14-18 are unpatentable pursuant to 35 U.S.C. § 103(a) over Bohnert, *et al.* (US 5,797,470) (hereinafter “Bohnert”).
- 2). Whether claims 4-5 are unpatentable pursuant to 35 U.S.C. § 103(a) over Bohnert in view of Imai, *et al.* (US 5,898,155) (hereinafter “Imai”).
- 3). Whether claims 10-13 are unpatentable pursuant to 35 U.S.C. § 103(a) over Bohnert in view of Caldwell (US 4,754,126).

(vii)

ARGUMENT

The Applicable Legal Standards for 35 U.S.C. § 103 (a) Rejections

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembicczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

Evidence of record must teach or suggest the recited features. An assertion of knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). Patentability determination must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action requiring appeal does not meet these burdens.

The 35 U.S.C. § 103(a) Rejections are legally improper

The rejections are devoid of any teaching, suggestion, or motivation

Appellants traverse the rejections on the grounds that Appellants' claims recite features and relationships which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features and relationships recited in Appellants' claims patentably distinguish over the applied reference(s).

The rejections are based on hindsight reconstruction

The only suggestion for the recited features and relationships is found in Appellants' own novel disclosure. It follows that the rejections are based solely on hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

The Office has not established a *prima facie* showing of obviousness

The Office has not established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified the reference(s) as alleged to have produced the recited invention. Thus, Appellants respectfully submit the rejections are improper and should be reversed.

The Claims Are Not Obvious Over
Bohnert

Claims 1-3, 6-9, and 14-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bohnert.

The Action alleges that Bohnert teaches a POS terminal (17), a cash acceptor (52), a card reader (53), and a receipt printer (54). The Action further alleges that the “receipt is ejected out of the receipt printer 54 intermediate of an exterior wall and an overlying member with an aperture and an edge, where the aperture extends into the overlying member from the edge”. The Office admits (on Action page 3) that Bohnert does not teach or suggest “moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member”. That is, the Office admits that Bohnert alone does not “teach or fairly suggest” recited step (d) of claim 1.

The Office further alleges that since Bohnert teaches a “tear bar”, it would have been obvious to move a receipt “while in sandwich relation between the exterior wall of the machine and the overlying member in order to protect the receipt from weather conditions (i.e., strong winds rain, snow) to prevent the receipt from blowing away from the machine and/or getting wet”.

Claim 1

The obviousness type rejection is based on Bohnert alone. No other prior art teaching or suggestion is being relied upon by the Office to support the rejection. The Office’s own admission that Bohnert does not teach or suggest recited step (d) is *prima facie* evidence that Bohnert alone cannot teach or suggest the recited features, relationships, and steps. That is,

Appellants respectfully submit that the Office's admission of deficiencies in Bohnert, without any other teaching or suggestion to alleviate the admitted deficiencies, constitutes an admission that the rejection is improperly based on mere assertions and not concrete evidence of record. The record admittedly lacks substantial evidence support for the rejection. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established. Therefore, the 35 U.S.C. § 103(a) rejection of claim 1 is not legally valid.

Even without the (factually correct) admission by the Office as to Bohnert lacking a teaching or suggestion of the recited method, Bohnert still would not teach or suggest the recited features, relationships, and steps. The rejection is not even based on the actual claim language. The Office relies on language other than what is actually recited, and then rejects the claim based on this (water-downed) misread language. For example, the Office alleges that it would be obvious to have Bohnert move a receipt "while in sandwiched relation between the exterior wall of the machine and the overlying member". However, claim 1 is actually directed to moving a receipt that is sandwiched "between a *finger extended in the aperture* and the exterior wall". Thus, in the rejection the Office improperly substitutes "overlying member" for the recited "finger extended in the aperture". Since the Office has not addressed the actual claim language (or the features associated therewith), a *prima facie* case of obviousness has not established.

Bohnert is non analogous art

Bohnert is directed to a fuel dispensing (14). Bohnert relates to accepting fuel *payments*, whereas claim 1 relates to accepting *deposits*. Even the Action (at page 8, line 1) admits that Bohnert does not teach or suggest "depositing an article". Bohnert is non analogous art.

The Office has not properly considered Appellants' disclosure in determining the meaning of terms used in the claim. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995). Nor has the Office granted a heavy presumption that the claim terms have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art. *Texas Digital Sys, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 64 USPQ2d 1812 (Fed. Cir. 2002). One skilled in the art of conducting transactions at a deposit accepting machine (e.g., bank customers) would understand the meaning of a "deposit" (Appellants' Specification page 1, lines 2-4).

Appellants also question the allegation that Bohnert teaches a deposit accepting *machine*. The Action is conveniently silent as to which of Bohnert's numbered elements allegedly constitutes the recited "machine". Nevertheless, Bohnert does not teach or suggest a machine in the manner recited.

In Bohnert the terminals (17, 18) are free-standing and are situated *independently* from the fuel dispensers (14, 20) (col. 4, lines 17-19). The terminals (17, 18) and fuel dispensers (14, 20) do not even communicate with each other, but rather separately communicate with a remote central master terminal (19) (Figure 2). A terminal (17, 18) is not part of a fuel dispenser (14, 20). However, Bohnert requires both a terminal (17, 18) and a fuel dispenser (14, 20) to conduct a fuel dispensing transaction. That is, Bohnert requires a user to operate distinct *machines* to carry out a single transaction. Conversely, claim 1 recites that it is the same machine where the transaction is conducted and where the transaction receipt is printed.

Bohnert's receipt retrieval operation is conventional

In an exemplary embodiment of Appellants' invention (e.g., Specification pages 16-17) a user cannot fully grasp a receipt until it is fully printed. This arrangement prevents a user from prematurely pulling on a receipt and damaging the printer or pulling out extra paper from the machine (page 16, lines 11-12; page 17, lines 15-16). Only after the user has first advanced the receipt with a finger can the user then fully grasp the receipt to remove it. Bohnert does not teach or suggest this manner of retrieving a receipt. Conversely, Appellants respectfully submit Bohnert's manner of receipt retrieval is conventional.

Without any contrary evidence of record, Appellants respectfully submit that retrieval of a receipt in Bohnert is carried out in the following conventional manner. An end of the receipt in Bohnert is extended (by the terminal) outward far enough beyond the end of the alleged overlying member (i.e., the angled member overlying the receipt outlet). The extended and exposed receipt end can then be conventionally grasped by hand and pulled with enough force to tear it (via the tear bar 24) from the receipt paper supply.

It is also conventional in the art to use a tear bar without requiring any aperture in the overlying member. The Office's reliance on Bohnert's use of a tear bar as a basis for the rejection is without merit. The Office has presented no evidence that an aperture (and use thereof in the manner recited) is always required with a tear bar.

Nor has the Office explained why the use of a tear bar in Bohnert would necessarily require the use an aperture to retrieve a receipt in the manner recited, as the Office apparently alleges. There is no evidence of record that Bohnert's use of a tear bar would require a user to retrieve the receipt by moving the receipt in sandwiched relation between a finger (extended in an

overlying member aperture) and an exterior wall of Bohnert's terminal (17). Again, the receipt in Bohnert is conventionally presented outward beyond the end of the overlying member where it can then be easily grasped by hand. An aperture is not needed nor used in the receipt retrieval.

The Office's reliance on the weather also points to the conventionality of Bohnert. The Office's allegation of protecting Bohnert's receipt from the weather actually teaches away from Bohnert needing any aperture in the alleged overlying member. An aperture would enable Bohnert's receipt to get wet. One skilled in the art would recognize that an overlying member without any aperture (i.e., a solid member) would provide the best protection against the weather. Without the need of an aperture (to enhance protection from the weather, as alleged by the Office), Bohnert further has no need to use an aperture to retrieve a receipt in the manner recited.

The Office has not shown any evidence that Bohnert's receipt presenting operation is non-conventional. Nor has the Office rebutted Appellants' position that it is conventional in the art to use a tear bar (like in Bohnert) *without* the need of an aperture in an overlying member. If Bohnert's receipt retrieval operation was so unique (as the Office apparently alleges) then why wasn't it ever mentioned by Bohnert? Again, there is no evidence of record that Bohnert, just because he has a tear bar, uses of an aperture in an overlying member to retrieve a receipt in the manner recited.

The Action's motivation for obviousness is flawed. A valid basis for *prima facie* obviousness has not been established.

Bohnert does not teach or suggest recited step (c)

Bohnert does not teach or suggest an overlying member having an aperture therein that is sized for accepting a finger of a user of a deposit accepting machine (step c). Bohnert is silent

regarding the structure adjacent the receipt printer (54). It follows that any interpretation by the Office is purely speculative. However, a rejection cannot legally be based upon speculation. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). The Office cannot add to Bohnert that which Bohnert does not specifically teach or suggest. The record lacks one iota of evidence that Bohnert teaches or suggests an overlying member having an aperture therein that is sized for accepting a machine user's finger.

Bohnert lacks using an aperture in the manner recited

Claim 1 is directed to a method, not an apparatus. Even if it were somehow possible for Bohnert to somehow teach or suggest an overlying member aperture sized for a finger, there would still be no teaching or suggestion of using the aperture to manually move a receipt, especially in the manner recited in method step (d). For example, what would prevent the alleged aperture in Bohnert from being only used to enable a person to see that no receipt had yet been printed? Without an aperture for viewing the receipt exit area, an impatient person may incorrectly assume that the receipt was already printed and that, instead of extending outward beyond the end of the overlying member for grasping as expected, it jammed under the overlying member. That is, in such scenario the alleged overlying member aperture would *not* be used for moving a receipt via a user's finger (as recited), but rather for visually informing the user as to whether the receipt was ever printed. A printed receipt in Bohnert would still be conventionally presented to the user in the manner previously discussed.

In another alternative use the alleged overlying member aperture in Bohnert, what would prevent the aperture from being made merely for cosmetic appearance? Also, the use of apertures is a known manufacturing technique for using less material to achieve the same

structural ability with less cost. What prevents the alleged aperture in Bohnert from being used solely to reduce costs, with no association whatsoever with moving the receipt in the manner recited?

In yet another alternative use the alleged aperture in Bohnert, what would prevent the aperture from being only used to prevent receipt curl?

Any function attributed to Bohnert of using an aperture in an overlying member for moving a receipt via a user finger (absent an explicit teaching or suggestion) is pure speculation on the part of the Office. Because the rejection relies on pure speculation, instead of concrete evidence that Bohnert actually uses an overlying member aperture in moving a receipt in the method recited, the Office has not established a *prima facie* case of obviousness.

Bohnert lacks moving a receipt in the manner recited

There is no teaching or suggestion of record to modify Bohnert to perform step (d). Bohnert does not teach or suggest moving a receipt in sandwiched relation between a finger (extended in an aperture of an overlying member) and an exterior wall of a deposit accepting machine to remove the receipt (as admitted by the Office). Bohnert does not even teach or suggest having a receipt sandwiched between a finger and the exterior wall of Bohnert's terminal (17).

For sake of argument, even if it were somehow possible for Bohnert to have (which he does not) an overlying member with an aperture sized for accepting a finger of a user, there still would not be any teaching or suggestion of using the aperture for moving a receipt in the manner recited. Again, Bohnert does not explicitly teach or suggest the recited method.

Bohnert is silent as to exactly how a user retrieves a receipt. Thus, by default it must be concluded that Bohnert retrieves a receipt in the conventional manner previously discussed. Any interpretation by the Office regarding receipt removal in Bohnert is again purely speculative. A valid rejection cannot legally be based upon such speculation. The Office has not provided concrete evidence of record.

Nor does Bohnert inherently teach or suggest the recited method. *In re Robertson*, supra. Structure that absolutely requires the carrying out of the recited method is not “necessarily present” in Bohnert. There is no prior art evidence of record that Bohnert’s device, in its normal and usual operation, would *necessarily* perform the method claimed. For example, where does Bohnert’s structure limit a user to only moving a receipt in the manner recited in step (d)? One skilled in the art would understand that Bohnert’s structure does *not* require moving a receipt in the manner recited in step (d). The Office has not established that moving a receipt in sandwiched relation between a finger in an overlying member aperture and an exterior wall is mandatory or “necessarily present” in Bohnert.

For further example, where is a prior art teaching or suggestion that the user in Bohnert is specifically *prevented* from grasping an extended presented receipt in order to graspingly move the receipt, i.e., *without* requiring insertion of a finger in the alleged aperture? What feature in Bohnert prevents a presented end of a receipt (exposed outward from the end of the overlying member) from being sandwiched between a finger and (instead of an exterior wall of the terminal) a thumb? Under such scenario (with Bohnert having an aperture sized for accepting a finger, for sake of argument) Bohnert still would lack a teaching or suggestion of moving a receipt in sandwiched relation between “a finger” (single) in the overlying member aperture and

the exterior wall of the terminal (17). It follows that the recited method is not “necessarily present” in Bohnert. *In re Robertson*, *supra*.

Bohnert does not explicitly teach or suggest the recited method. Nor does the apparatus of Bohnert teach or suggest the recited method under the principles of inherency. As a result, Bohnert cannot render obvious the claimed process.

Bohnert structurally teaches against the recited method

The Office has not established that Bohnert’s disclosed structure is even capable of performing the recited method. In Bohnert the area adjacent the receipt printer (54) has an angled overlying member (Figure 7) extending outwardly therefrom. At best, Bohnert’s angled overlying member acts as a receipt guiding member that guides a receipt in a designed direction (downward and outward toward the user) away from the receipt outlet.

Bohnert structurally teaches against the recited invention. Located behind Bohnert’s angled guide member (Figure 7) is an opening, cutout, or recessed cavity portion at the exterior wall of the terminal (17). That is, there is no wall structure directly adjacent to the angled guide. It follows that there is no “exterior wall” to which the receipt could be sandwiched against. The Office has not established a *prima facie* case of obviousness.

Bohnert further structurally teaches against the recited invention. As recognized by one having ordinary skill in the art, because of the guide member’s angle, a significant increasing gap (located behind or under the guide) exists between the angled guide and the exterior wall of the terminal (17). One having ordinary skill in the art would recognize that it is conventional for a receipt guide to be angled (like in Bohnert) in order to make grasping and tearing the receipt easier. Bohnert’s use of a conventional angled guide points to a receipt retrieval operation in

which the receipt end is conventionally presented outward past the guide end to a position where it can be easily grasped by the user's hand. No aperture is needed in Bohnert's angled receipt guide during receipt retrieval. It follows that Bohnert's reliance on a conventional angled guide actually teaches away from the recited receipt retrieval operation. The Office has not established a *prima facie* case of obviousness.

In contrast to Bohnert's teaching of an angled overlying member, in an exemplary arrangement (Figure 38) of Appellants' invention the exterior wall (121) and overlying member (30) are substantially parallel.

Further, Bohnert's angled guide member is designed to direct the receipt in a direction for presentation toward the user. This angled direction from the terminal (17) makes it easier for the user to grasp and retrieve the receipt. Why would a user (if it were somehow even possible, for sake of argument) want to push the receipt (via a finger in the alleged aperture) in a reverse direction toward the terminal exterior wall, especially when such action would push the receipt away from the user and be directly contrary to the design and purpose of the angled guide? With Bohnert's wide angled guide a receipt would be presented to a user a correspondingly wide distance away from the terminal. With the intent of such a wide distance, pushing the receipt with a finger in a reverse direction away from the intended direction (away from the user) would be unreasonable. The Office has not established a *prima facie* case of obviousness.

As previously discussed, one having ordinary skill in the art would come to an understanding that in Bohnert a receipt end is conventionally positioned by the printer at a location past the outmost end of the angled guide where it can then be manually grasped by hand by the user. There is no teaching or suggestion whatsoever on record of extending a finger in an

overlying member aperture in the manner recited to move a deposit transaction receipt. Again, Bohnert does not explicitly or inherently teach or suggest the recited method.

The alleged modification to Bohnert would destroy his teaching

The alleged operational modification to Bohnert's angled guide would destroy the utility and operability of the Bohnert's conventional device. An obviousness rejection cannot be based on a modification that results in destroying the utility or advantage of the device shown in the prior art reference. Note *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). Again, the Office has not established a *prima facie* case of obviousness.

The alleged modifications to Bohnert would not have produced the recited invention

Again for sake of argument, Bohnert would not teach or suggest the recited method even if Bohnert were to teach (which he does not) the angled guide both (1) having an aperture sized for accepting a finger and (2) being located near the exterior wall structure of the terminal (17) (instead of opposite a recessed cavity). In Bohnert the depth of the underlying gap caused by the angled guide is structurally too large a distance for a finger to extend across to reach the exterior wall of the terminal (17), especially while the finger remains extended "in the aperture".

Additionally, because of the guide's angle, a finger perpendicular in the (angled) aperture would have to be bent and angled back toward the user. This would cause the finger to be at an angle to the receipt. That is, a finger in the alleged aperture of Bohnert (if it were somehow possible, for sake of argument) would be awkwardly set at an angle relative to the receipt. If somehow possible, the receipt would be engaged with an angled finger nail. The angle would not enable pulling of the receipt. That is, even if it were somehow possible (for sake of argument) for a user in Bohnert to be willing and able to perform such finger gymnastics, there would still

be insufficient leverage/frictional contact to properly push the receipt to cause enough tension to tear it, as Bohnert requires. Again, Bohnert's angled structure actually teaches away from Bohnert sandwiching a receipt between a (single) finger in an overlying member aperture and the exterior wall to move the receipt.

Again, even including all of the Office's alleged modifications thereto, Bohnert still would not explicitly or inherently teach or suggest the recited method.

The record lacks substantial evidence support for the rejection

The Office's allegation of obviousness is based on unsupported speculation. The record lacks substantial evidence support for the rejection. *In re Zurko*, supra. *In re Lee*, supra. Appellants are entitled to see and address the evidence on which their patent grant is being denied. Since this evidence has not been presented, it must be concluded that it does not exist.

The Appellants are not required to prove patentability. Contrarily, it is the Office which must establish a *prima facie* case of obviousness under the law. Otherwise, the Office is legally required to grant a patent. Appellants respectfully submit that the Office's burden of establishing a *prima facie* case of obviousness has not been met.

A *prima facie* case of obviousness has not been established

Appellants have shown that Bohnert neither functionally nor structurally teaches or suggests the recited method. The Office has not established a *prima facie* conclusion of obviousness. The Action is devoid of any such teaching, suggestion, or motivation for combining prior art features so as to produce the recited invention. Bohnert does not teach or suggest the recited features and relationships. Even the Office admits this fact.

Nor has the Office established a prior art desirability for modifying Bohnert to produce the recited invention. The rejection is based solely on hindsight reconstruction of Appellants' claimed invention, which is legally impermissible. *In re Fritch*, supra.

It would not have been obvious to have modified Bohnert as alleged to have produced the recited invention. For the many reasons discussed above, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 1 should be withdrawn.

Claim 2

Bohnert further does not teach or suggest moving a receipt in the manner recited.

Bohnert does not teach or suggest moving a receipt in sandwiched engagement between a finger and an exterior wall of the terminal (17). The Office has not established a *prima facie* case of obviousness.

Claim 3

Claim 3 depends from claim 2. The record is devoid of any evidence that Bohnert teaches or suggests moving a receipt with a finger in a generally downward direction in the manner recited. Even the Office admits (at Action page 3, last two lines) that Bohnert does not teach or suggest that a "receipt is moved with a finger moving in generally a downward direction". The Office has not established a *prima facie* case of obviousness.

Claim 6

Claim 6 depends from claim 1. Bohnert further does not teach or suggest the relationships of the overlying member, aperture, exterior wall, and opening. Bohnert does not teach or suggest an exterior wall including an opening, where the alleged overlying member extends from generally above the opening to an edge positioned below the opening. Nor does

Bohnert teach or suggest an aperture (in the alleged overlying member) extending below the opening. Nor does Bohnert teach or suggest moving a receipt downward by movement of a finger in the alleged aperture. As Bohnert is silent as to the structural arrangement of the alleged overlying member relative to other structure, the Office's allegation of obviousness is based on unsupported speculation. A valid rejection cannot legally be based upon such speculation.

For sake of argument, even if Bohnert had an aperture and an opening, what would prevent the aperture from extending above (or equal with) the opening? That is, what prior art teaching or suggestion specifically prevents Bohnert from having structure differing from that recited in the claim? It follows that structure capable of carrying out the recited method is not even "necessarily present" in Bohnert. *In re Robertson*, supra. The Office has not established a *prima facie* case of obviousness.

Claim 7

Claim 7 depends from claim 1. Bohnert further does not teach or suggest the recited overlying member and exterior wall proximity relationship. Bohnert does not teach or suggest that the alleged overlying member is disposed in proximity to an exterior wall so that a receipt extending therebetween "*cannot* be manually grasped" with fingers prior to moving the receipt by engagement with a (single) finger through an aperture (in the overlying member). Conversely, as previously discussed (e.g., claim 1 remarks), Bohnert's large gap (due to the angled guide member) permits a receipt to be manually grasped with (plural) fingers prior to moving the receipt.

Nor does Bohnert teach or suggest manually grasping the receipt after moving the receipt with a finger. It follows that Bohnert also does not teach or suggest moving a receipt in the order recited.

The relied upon section of Bohnert (at col. 6, lines 30-38) does not teach or suggest the recited method. Nor has the Office established a *prima facie* case of obviousness.

Claim 8

Claim 8 depends from claim 6/1. Bohnert further does not teach or suggest the relationship among an aperture, a receipt, and a thumb in the manner recited. Where does Bohnert teach or suggest an aperture in the alleged overlying member that is centered relative to a receipt? Where does Bohnert further teach or suggest an aperture in the alleged overlying member that is sized for accepting a thumb therein? Nor does Bohnert teach or suggest moving a receipt downward by movement of a thumb. The Office has not established a *prima facie* case of obviousness.

Claim 9

Claim 9 is directed to cutting a receipt with a cutter. Where does Bohnert teach or suggest cutting the receipt paper? Bohnert teaches “manually tearing a printed receipt” (col. 6, lines 34-35)? As evidenced by Action page 7, the Office relies on Imai for a teaching of cutting.

Where does Bohnert teach or suggest that movement of a receipt in sandwiched relation between a finger extended in an aperture and an exterior wall is operative to cut the receipt in the manner recited? The relied upon section of Bohnert (at col. 6, lines 30-38) does not teach or suggest the recited method. The Office has not established a *prima facie* case of obviousness.

Claim 14

Bohnert further does not teach or suggest fitting a panel on an exterior surface of an *existing* deposit accepting machine, where the printer is housed in the panel. In an exemplary embodiment (page 20, lines 12-15; Figure 38) of the invention, a control panel (16) is retrofit to an existing depository. Bohnert does not teach or suggest a panel or retrofitting. The Office has not established a *prima facie* case of obviousness.

Claim 15

Claim 15 depends from claim 14/1. Bohnert further does not teach or suggest receipt indicia including an inputted value in the manner recited. Bohnert has a conventional gasoline station receipt (col. 5, lines 64-65). Where does Bohnert teach or suggest inputting a value through an input device, and printing a receipt having indicia including the input value? The relied upon sections of Bohnert (at col. 3, line 62 to col. 6, line 52; and col. 10, line 47 to col. 11, line 23) do not teach or suggest the recited method. The Office has not established a *prima facie* case of obviousness.

Claim 16

Appellants' remarks in support of the patentability of claim 1 are incorporated herein by reference. Bohnert does not teach or suggest the recited method. For example, for reasons previously discussed, Bohnert does not teach or suggest moving a receipt in the manner recited. The Office has not established a *prima facie* case of obviousness. It would not have been obvious to have modified Bohnert as alleged to have produced the recited invention.

Claim 17

Claim 17 depends from claim 16. For reasons already discussed, Bohnert also does not teach or suggest the relationships of an overlying member, a generally downward facing edge, an exterior wall, an opening, and a receipt in the manner recited. Even the Office admits (at Action page 3, last two lines) that Bohnert does not teach or suggest that a “receipt is moved with a finger moving in generally a downward direction”. Again, the Office has not established a *prima facie* case of obviousness.

Claim 18

Claim 18 includes a combination of subject matter from claims 1, 3, 6, 7, and 16. Appellants’ remarks in support of the patentability of these claims are incorporated herein by reference.

As previously discussed, Bohnert does not teach or suggest the steps, features, and relationships that are specifically recited in any of claims 1, 3, 6, 7, and 16. It follows Bohnert cannot teach or suggest the combination of steps, features, and relationships that are specifically recited in claim 18.

Furthermore, even the Action (at page 6) admits that Bohnert does not teach or suggest “moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member, wherein the receipt is moved generally downward by movement of the finger”. As the obviousness type rejection is based solely on the admittedly deficient Bohnert, a *prima facie* case of obviousness has not established. The record lacks substantial evidence support for the rejection. *In re Zurko*, supra. *In re Lee*, supra.

Also, for reasons previously discussed, Bohnert does not teach or suggest recited step (a).

Bohnert's exterior wall of terminal (17) does not include an opening such that the alleged overlying member extends from generally above the opening to a generally downward facing edge positioned below the opening. Nor does Bohnert teach or suggest an aperture (in the alleged overlying member) extending below the opening. As Bohnert is silent regarding the structure adjacent the receipt printer (54), the Office's allegations of recited features being in Bohnert are based on unsupported speculation. Again, a valid rejection cannot legally be based on speculation.

For sake of argument, even if Bohnert had (which he does not) an aperture and an opening, what teaching or suggestion in Bohnert prevents the aperture from extending above (or equal with) the opening? That is, what prevents Bohnert from having structure different from that in the claim? There is no evidence that Bohnert teaches or suggests structure that dictates that the recited method must be carried out. It follows that structure that absolutely requires the carrying out of the recited method is not "necessarily present" in Bohnert. *In re Robertson*, supra. Thus, Bohnert does not explicitly or inherently teach or suggest the recited method.

For further example, for reasons previously discussed, Bohnert also does not teach or suggest recited step (b). Bohnert does not teach or suggest an overlying member being disposed in proximity to an exterior wall of the terminal (17) so that a receipt extending therebetween "*cannot* be manually grasped" with (plural) fingers prior to moving the receipt by engagement with a (single) finger through the aperture. Conversely, as previously discussed (e.g., claim 1 remarks), Bohnert's use of angled guide member permits a receipt to be manually grasped by hand. Bohnert's use of an angled member points to (at best) his receipt being initially moved by

a hand that is located outside of and beyond the overlying member, not by being moved between a (single) finger and an exterior wall of the terminal (17). With Bohnert's angled member, a presented receipt *can* be manually grasped by hand (including plural fingers) prior to any necessary earlier movement of the receipt by a user's (single) finger. Thus, Bohnert does not teach or suggest recited step (b).

Nor does Bohnert teach or suggest "manually grasping the receipt" (step c) *subsequent* to moving the receipt by movement of a finger (step b). Bohnert does not teach or suggest moving a receipt in the order recited. It follows that Bohnert does not explicitly or inherently teach or suggest the recited method.

Again, the Office's allegation of obviousness is based on pure speculation. The record lacks substantial evidence support for the rejection. *In re Zurko*, supra. *In re Lee*, supra. Bohnert does not teach or suggest moving a receipt in the manner recited. The Office has not established a *prima facie* case of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified Bohnert as alleged to have produced the recited invention.

**The Claims Are Not Obvious Over
Bohnert in view of Imai**

Claims 4-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bohnert in view of Imai.

Claim 4

Claim 4 is directed to cutting supply roll paper with a cutter. The Action (on page 7) admits that Bohnert does not teach or suggest using a paper roll. The Office relies on Imai for

teaching a paper roll and a cutter. However, Imai cannot be used to alleviate the admitted deficiencies of Bohnert.

Bohnert teaches “manually tearing a printed receipt” (col. 6, lines 34-35). Bohnert teaches against having any cutting occur *prior* to receipt movement. That is, Bohnert teaches away from cutting the paper *prior* to manually moving the receipt in the manner of step (d).

The rejection is based solely on an attempt at hindsight reconstruction of Appellants’ claimed invention, which is legally impermissible. *In re Fritch*, supra.

Additionally, the alleged modification to Bohnert’s teaching (i.e., manually tearing during receipt movement) would destroy the disclosed utility and operability of Bohnert. The rejection is not valid because it results in destroying the utility or advantage of Bohnert’s explicit teaching. *In re Fine*, supra. The Office has not established a *prima facie* case of obviousness.

Claim 5

Claim 5 depends from claim 4/1. The Action (on page 7) admits that Bohnert/Imai does not teach or suggest that “the cutting step is executed *when* the receipt extends below an aperture but not substantially below the edge of the overlying member”. That is, the Office admits that the combination of Bohnert and Imai still would not teach or suggest the recited method.

The attempt in the Action to have Bohnert’s receipt cut when it is exactly positioned as recited is based solely on hindsight reconstruction of Appellants’ claimed invention, which is legally impermissible. *In re Fritch*, supra.

The *reason* provided in the Action to cut Bohnert’s receipt when it is exactly positioned as recited is without merit. If one were actually concerned about Bohnert “cutting the receipt prematurely” then one would have it cut after it extended substantially below the overlying

member. Yet such positioning (based on the Office's reasoning) would be contrary to cutting the receipt when it is “not substantially below” the overlying member. The Office has not established a *prima facie* case of obviousness.

**The Claims Are Not Obvious Over
Bohnert in view of Caldwell**

Claims 10-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bohnert in view of Caldwell.

Claim 10

The Action (at page 8, first paragraph) admits that Bohnert does not teach or suggest “depositing an article in the machine and inputting an article identifying number through an input device, and printing on the receipt the article identifying number”.

Caldwell does not teach or suggest the features that are admitted to be absent from Bohnert. Nor would it have been obvious to one having ordinary skill in the art to have combined the references as alleged to have produced the claimed invention.

The Action is silent as to which of Caldwell's numbered elements allegedly constitutes the recited features. Where does Caldwell teach or suggest inputting an article *identifying* number through an input device and printing the article identifying number on a receipt in the manner recited? The relied upon section of Caldwell (at col. 1, line 43 to col. 2, line 17) does not teach or suggest the recited features.

In Caldwell a customer chooses a “commercial deposit” transaction, then enters an appropriate amount on the keyboard and signals “ready” by using a function key as shown in the

block (132) (col. 5, lines 60-66; Figure 7A). There is no teaching or suggestion in Caldwell of entering an “article *identifying* number”. Nor is there any teaching or suggestion that a receipt includes the entered article identifying number.

The Office has not established a *prima facie* showing of obviousness. The Action is devoid of any teaching, suggestion, or motivation for combining features of the references to produce the recited invention. The prior art does not teach or suggest the desirability of the combination. Even if it were somehow possible for the references to be combined as alleged, the resultant combination still would not result in the claimed invention. The references, taken alone or in combination, do not teach or suggest the recited features, relationships, and steps.

Claim 11

The Action (at page 8, first paragraph) admits that Bohnert does not teach or suggest “depositing an article in the machine”. Appellants respectfully submit that Bohnert also does not teach or suggest inputting an “amount associated with the article”, and printing the amount “on the receipt”.

In Caldwell a customer chooses a “commercial deposit” transaction, then enters an appropriate amount on the keyboard and signals “ready” by using a function key as shown in the block (132) (col. 5, lines 60-66; Figure 7A). The ATM records the appropriate data relating to the transaction in block (144) (col. 6, lines 17-18; Figure 7B). There is no teaching or suggestion in Caldwell that the entered amount is ever printed on a receipt. Caldwell appears more concerned with the receipt providing a dated record (for physical evidence that the customer attempted a deposit at a certain time).

The Action's assertions are not based on any evidence in the record. *In re Zurko*, supra. *In re Lee*, supra. The Office has not established a *prima facie* showing of obviousness. The references, taken alone or in combination, do not teach or suggest the recited features, relationships, and steps. It would not have been obvious to one having ordinary skill in the art to have combined the references as alleged to have produced the claimed invention.

Claim 12

The Action (on page 8) admits that Bohnert does not teach or suggest "opening a depository door to a depository and placing a deposit article in the opening". That is, the Action admits that Bohnert's gasoline station does not have a *depository* (nor a depository door). By inference the Action admits that Bohnert does not teach, suggest, need, or desire any aspect of claim 12.

Caldwell does not teach or suggest equipping a gasoline station with a depository having a door. The prior art does not teach or suggest the desirability of the combination. The Action is devoid of any such teaching, suggestion, or motivation for modifying Bohnert's gasoline station to include a depository with a door so the door can be opened to place a deposit article therein. Nor has the Office addressed the regulatory and safety issues against having a depository on a fuel island. The Office has not established a *prima facie* showing of obviousness.

Nor has the Action explained how Bohnert's fuel island could be structurally modified to include such a depository (especially in light of the Action's admission that Bohnert lacks a depository). It would not have been obvious to one having ordinary skill in the art to have combined the references as alleged to have produced the claimed invention.

Claim 13

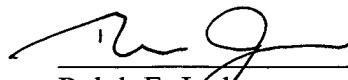
Claim 13 depends from claim 12/1. The Action (on page 8) admits that Bohnert does not teach or suggest that a “depository door is unlocked responsive to both input of a card to a card reader in operative connection with the depository door and placing a key in a key actuator in operative connection with the depository door”. That is, the Office admits that Bohnert does not unlock a depository door with a card and a key.

The Action relies on Caldwell (at col. 3, line 25 to col. 6, line 2). Appellants respectfully submit that Caldwell cannot alleviate the admitted deficiencies of Bohnert. Caldwell states (e.g., at col. 3, lines 57-64) that the depository door (22) is controlled by the ATM or alternatively by a key lock. Where has the Office established a *prima facie* showing of obviousness?

CONCLUSION

Each of Appellants’ pending claims specifically recites features, relationships, and steps that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for combining features of the applied prior art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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(viii)



1. A method comprising the steps of:
 - (a) conducting at least one transaction at a deposit accepting machine;
 - (b) printing a receipt including indicia corresponding to the transaction with a printer in an interior area of the machine;
 - (c) extending a receipt intermediate of an exterior wall of the machine and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user;
 - (d) moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member.
2. The method according to claim 1 wherein the overlying member includes an edge, and wherein the aperture extends into the overlying member from the edge, and wherein in step (d) the receipt is moved by a finger moving from inside the aperture to outside the aperture with the receipt in sandwiched engagement between the finger and the exterior wall.

3. The method according to claim 2 wherein the edge of the member is a downward facing edge, and wherein in step (d) the receipt is moved with a finger moving in generally a downward direction.
4. The method according to claim 1 wherein the receipt is printed on paper supplied from a roll and prior to step (d), further comprising the step of, cutting the paper with a cutter to separate the receipt from the roll.
5. The method according to claim 4 wherein the overlying member terminates in an edge, and wherein the cutting step is executed when the receipt extends below the aperture but not substantially below the edge.
6. The method according to claim 1 wherein the exterior wall includes an opening, and wherein in step (c) the receipt extends through the opening, and wherein the overlying member extends from generally above the opening to an edge positioned below the opening, wherein the aperture extends below the opening, and wherein in step (d) the receipt is moved downward by movement of the finger in the aperture.
7. The method according to claim 1 wherein the overlying member is disposed in proximity to the exterior wall such that a receipt extending therebetween cannot be manually

grasped with fingers prior to moving the receipt by engagement with a finger through the aperture, and thereafter further comprising manually grasping the receipt.

8. The method according to claim 6 wherein the aperture extends in the overlying member from the edge, is generally centered relative to the receipt, and is sized for accepting a thumb therein, wherein in step (d) the receipt is moved by downward movement of the thumb.
9. The method according to claim 1 and further comprising the step of:
cutting the receipt with a cutter, wherein movement of the receipt in step (d) is operative to cut the receipt.
10. The method according to claim 1 wherein in step (a) conducting the transaction includes depositing an article in the machine and inputting an article identifying number through an input device, and wherein in step (b) the indicia printed on the receipt includes the article identifying number.
11. The method according to claim 1 wherein in step (a) conducting the transaction includes depositing an article in the machine and inputting through an input device at least one amount associated with the article, and wherein in step (b) the indicia printed on the receipt includes the amount.

12. The method according to claim 1 wherein in step (a) conducting the transaction includes opening a depository door to a depository and placing a deposit article in the opening.
13. The method according to claim 12 wherein in conducting the transaction in step (a) the depository door is unlocked prior to opening, and wherein the depository door is unlocked responsive to both input of a card to a card reader in operative connection with the depository door and placing a key in a key actuator in operative connection with the depository door.
14. The method according to claim 1 and prior to step (a) further comprising the step of fitting a panel on an exterior surface of an existing deposit accepting machine, wherein the printer is housed in the panel.
15. The method according to claim 14 wherein the panel on the exterior surface of the existing deposit accepting machine includes at least one input device, and wherein the transaction conducting in step (a) includes inputting at least one value through the input device, and wherein the indicia printed in step (b) includes the input value.
16. A method comprising the steps of:
 - (a) extending a printed receipt intermediate of an exterior wall of a deposit accepting machine and an overlying member, wherein the overlying

member includes an aperture therein sized for accepting a finger of a user;
and

- (b) moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member.

17. The method according to claim 16 wherein the overlying member includes a generally downward facing edge, wherein an opening is formed between the edge and the exterior wall, and wherein in step (b) the receipt is removed in a generally downward direction through the opening.

18. A method comprising:

- (a) extending a printed receipt intermediate of an exterior wall of a deposit accepting machine and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user, wherein the exterior wall includes an opening, wherein the overlying member extends from generally above the opening to a generally downward facing edge positioned below the opening, wherein the aperture extends below the opening;
- (b) moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior

wall and the overlying member, wherein the receipt is moved generally downward by movement of the finger in the aperture, wherein the overlying member is disposed in proximity to the exterior wall such that a receipt extending therebetween cannot be manually grasped adjacent the edge with fingers prior to moving the receipt by engagement with a finger through the aperture;

- (c) subsequent to (b), manually grasping the receipt.

(ix)

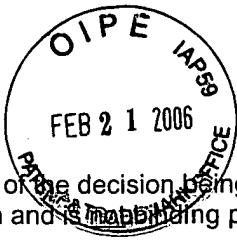
EVIDENCE APPENDIX

(None)

(x)

RELATED PROCEEDINGS APPENDIX

Attached is a copy of the Board decision (dated June 22, 2004) regarding Appeal No. 2003-0098, as identified in section (ii) of this Appeal Brief.



The opinion in support of the decision being entered today was not written for publication and is ~~not~~ binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ALAN J. ROZLOSNIK, STEVEN R. DAVIS
and MARK A. DEPIETRO

MAILED

JUN 22 2004

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2003-0098
Application No. 09/398,182

ON BRIEF

Before COHEN, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 18, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to banking machines (specification, p. 1). A copy of the dependent claims under appeal is set forth in the appendix to the appellants' brief. The independent claims on appeal read as follows:

1. A method comprising the steps of:
 - (a) conducting at least one transaction at a deposit accepting machine;
 - (b) printing a receipt including indicia corresponding to the transaction with a printer in an interior area of the machine;
 - (c) extending a receipt intermediate of an exterior wall of the machine and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user;
 - (d) moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member.
16. A method comprising the steps of:
 - (a) extending a printed receipt intermediate of an exterior wall of a deposit accepting machine and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user; and
 - (b) moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member.
18. A method comprising:
 - (a) extending a printed receipt intermediate of an exterior wall of a deposit accepting machine and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user, wherein the exterior wall includes an opening, wherein the overlying member extends from generally above the opening to a generally downward facing edge positioned below the opening, wherein the aperture extends below the opening;
 - (b) moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member, wherein the receipt is moved generally downward by movement of the finger in the aperture, wherein the overlying member is disposed in proximity to the exterior wall such that a receipt extending

therebetween cannot be manually grasped adjacent the edge with fingers prior to moving the receipt by engagement with a finger through the aperture;
(c) subsequent to (b), manually grasping the receipt.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Caldwell	4,754,126	June 28, 1988
Imai et al. (Imai)	5,898,155	Apr. 27, 1999
McCall	6,112,981	Sept. 5, 2000

Claims 1 to 3, 5 to 8 and 10 to 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Caldwell in view of McCall.

Claims 4 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Caldwell in view of McCall and Imai.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 10, mailed June 3, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 9, filed April 8, 2002) and reply brief (Paper No. 11, filed June 26, 2002) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 18 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In this case, the applied evidence (i.e., Caldwell, McCall and Imai) would **not** have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention for the reasons set forth in the brief and

reply brief. Method steps (c) and (d) of claim 1, method steps (a) and (b) of claim 16 and method steps (a), (b) and (c) of claim 18 are not taught or suggested by any of the applied prior art references. In that regard, we view the examiner's position that McCall's fuel dispenser 12 has a receipt dispenser, as indicated on page 9 of the answer, to be sheer speculation unsupported by the actual disclosure of McCall.¹

Since the claimed subject matter is not suggested by the applied prior art references for the reasons set forth above, we have no choice but to reverse the decision of the examiner to reject claims 1 to 18 under 35 U.S.C. § 103.

¹ While we agree with the examiner that receipt dispensers are known to exist on fuel dispensers at gas stations, none of the applied prior art references actually teach or suggest such a receipt dispenser. Instead of relying on McCall, the examiner should have cited and applied a prior art receipt dispenser (see In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)) if the receipt dispenser extended a printed receipt intermediate of an exterior wall of the fuel dispenser and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user; and moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member. In addition, it is not clear to us if the claimed "deposit accepting machine" is readable on a fuel dispenser that accepts debit and credit cards since the United States Patent and Trademark Office (USPTO) applies to the verbiage of the claims before it the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the appellants' specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 18 under 35 U.S.C. § 103 is reversed.

REVERSED



IRWIN CHARLES COHEN
Administrative Patent Judge

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BOARD OF PATENT
APPEALS
AND
INTERFERENCES



JEFFREY V. NASE
Administrative Patent Judge

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JENNIFER D. BAHR
Administrative Patent Judge